

## REMARKS

Claims 13-25 are pending in this application, of which claim 13 is independent. In this Amendment, claim 15 has been amended. Care has been exercised to avoid the introduction of new matter. Support for the amendments to claim 15 can be found in, for example, Figs. 1(a) and 1(b), and relevant description of the specification.

### **Claim Rejections – 35 U.S.C. § 112**

Claim 15 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Examiner asserted, “Applicant has not defined clearly if the flat surfaces of claim 13 are different from the four flat surfaces of claim 15” (page 2 of the Office Action).

In this Amendment, claim 15 has been amended to clarify the claimed subject matter. Applicants believe the amendments to the claim are fully responsive to the Examiner’s concerns. Withdrawal of the rejection of the claim is, therefore, respectfully solicited.

### **Double Patenting**

Claims 13-25 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of copending Application No. 10/944,332, which is now **U.S. Patent No. 7,490,536, issued February 17, 2009.**

Enclosed herewith is a terminal disclaimer to overcome the imposed rejection. Applicants, therefore, respectfully solicit withdrawal of the rejection of claims 13-25 under the judicially created doctrine of obviousness-type double patenting.

**Claim Rejections - 35 U.S.C. § 103**

Claims 13-25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over New (U.S. Patent No. 4,061,438) in view of Cobb (U.S. Patent No. 5,518,347). In the statement of the rejection, the Examiner admitted that New fails to teach flat surfaces that extend substantially parallel to the longitudinal axis of the shank. However, the Examiner asserted that Cobb teaches the missing features of New, and concluded that it would have been obvious to modify the boring bars of New based on the teachings of Cobb to arrive at the claimed subject matter. This rejection is respectfully traversed.

New and Cobb, individually or in combination, do not disclose or suggest a vibration suppressing cutting tool including all the limitations recited in independent claim 13, which reads:

13. A vibration suppressing cutting tool comprising a holder having a shank formed with a pocket in which a vibration suppressing piece which is not coupled to said holder is received so as not to be able to come off said pocket, wherein at least portions of the inner wall of said pocket that knock against said vibration suppressing piece or portions of the surface of said vibration suppressing piece that knock against said inner wall of said pocket are flat surfaces, whereby said vibration suppressing piece knock against the inner wall of said pocket along surfaces or at a plurality of portions when the holder vibrates during cutting, and the flat surfaces extend in a direction substantially perpendicular to a direction of vibration of the holder during cutting, the vibration direction being substantially perpendicular to the longitudinal axis of the shank.

In the Office Action, the Examiner specifically asserted that “it would have been obvious... to modify New’s vibration suppressing mass (thus also the cavity walls) [to be] flat, as taught by Cobb since Cobb teaches any convenient shape may be used depending the application (‘347, col. 4, lines 40-47)” (the last paragraph on page 7 of the Office Action). Since Cobb describes that “the dumper mass and elastomeric supports may be of any convenient

shape” (column 4, lines 45-26), the Examiner asserted that Cobb’s dumper mass 9 may have a surface that extends parallel to the longitudinal axis of the shank of the holder (the surface is referred to as an “axis surface”). Even if it is assumed that Cobb’s dumper mass 9 has the axis surface that extends parallel to the longitudinal axis of the shank of the holder for the sake of this response, persons skilled in the art would not be impelled to modify the New’s dumper mass 10 based on Cobb’s dumper mass 9.

For example, Cobb describes, “[t]he dumper mass 9 is supported at each first and second conical end 9a and 9b by respective first and second elastomeric supports 10a and 10b within the central cavity 6” (column 6, lines 37-40). Cobb apparently teaches that the axial surface of dumper mass 9 is maintained not to contact the inner wall of cavity 6. In contrast, the axial surface of dumping mass 10 of New knocks against the inner wall of the pocket to suppress vibration.

Accordingly, if dumper mass 10 of New were modified based on dumper mass 9 of Cobb, New’s modified dumper mass would not knock against the inner wall of the pocket to suppress vibration, irrespective of what shape New’s dumper mass has. It is, therefore, apparent that the applied combination of New and Cobb does not teach, among other things, “at least portions of the inner wall of said pocket that knock against said vibration suppressing piece or portions of the surface of said vibration suppressing piece that knock against said inner wall of said pocket are flat surfaces, whereby said vibration suppressing piece knock against the inner wall of said pocket along surfaces or at a plurality of portions when the holder vibrates during cutting, and the flat surfaces extend in a direction substantially perpendicular to a direction of vibration of the holder during cutting, the vibration direction being substantially perpendicular to the longitudinal axis of the shank,” as claimed.

Applicants note that it is well established that if proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). There is no justifiable reason to modify New's dumping mass based on Cobb's dumping mass because the proposed combination renders New's device unsatisfactory for its intended purpose because New's modified dumper mass, as discussed above, does not knock against the inner wall of the pocket to suppress vibration, whereas New's dumper mass is originally designed to knock against the inner wall of the pocket to suppress vibration. Therefore, there is no reason to modify New's dumping mass based on the teachings of Cobb to arrive at the claimed subject matter. *See In re Gordon*, 733 F.2d 900.

Based upon the foregoing, Applicants submit that the Examiner has not established a *prima facie* basis to deny patentability to the claimed invention for lack of the requisite factual basis and want of the requisite reason to justify the combination of the cited references. Applicants, therefore, submit that the imposed rejection of claim 13 under 35 U.S.C. §103 for obviousness predicated upon New and Cobb is not factually or legally viable and, hence, respectfully solicit withdrawal thereof.

Dependent claims 14-25 are also patentably distinguishable over New and Cobb at least because these claims respectively include all the limitations recited in independent claim 13. Applicants, therefore, respectfully solicit withdrawal of the rejection of claims 14-25 and favorable consideration thereof.

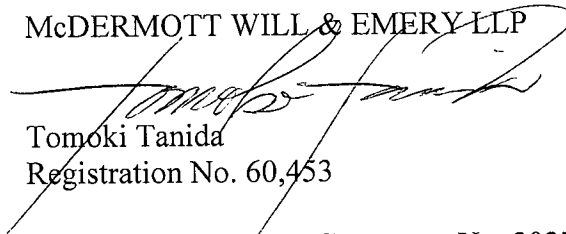
**Conclusion**

It should, therefore, be apparent that the imposed rejections have been overcome and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, respectfully solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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